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MAY 14 2009

OFFICE OF PETITIONS

In re Application of	:	
Song et al.	:	DECISION
Application No. 10/660690	:	ON PETITION
Filing or 371(c) Date: 09/11/2003	:	
Title of Invention:	:	
PLASMA DISPLAY PANEL	:	
DRIVING METHOD	:	

This is a decision on the Petition Under 37 CFR § 1.183, filed April 23, 2009, is properly treated as a petition under 37 CFR 1.183 to suspend or waive the requirement under 37 CFR § 1.175 that requires the named inventors to sign any supplemental declaration in a broadening reissue application.

The petition is **dismissed**.

Rule 47 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under [insert the applicable code section]"; should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

BACKGROUND

1. U.S. Patent No.6,288,693 (the '693 patent) issued to Young-Bok Song, Sang Jin Yun, Byeong Cheol Kim, Sung Wook Jung, Bong Koo Kang, Young Hwan Kim and Nam Kyu Lee on September 11, 2001.
2. A broadening reissue application (the present application) was filed for the '693 patent on September 11, 2003, and it was assigned application number 10/660690. In response to a

Notice to File Missing Parts of Reissue Application, Applicant filed an executed reissue oath/declaration on May 10, 2004.

3. During the prosecution of the present application, on November 26, 2008, the Office informed Applicant that the reissue oath/declaration was defective because it failed to identify at least one error, which is relied upon to support the reissue application.
4. Applicants file the present petition and a Supplemental Reissue Declaration on April 23, 2009 by inventors August 11, 2008 by inventors Nam Kyu Lee, Sang Jin Yun, Jin Won Hong¹, Bong Koo Kang, and Young Hwan Kim only. The signature of inventors Young-Bok Song, Byeong Cheol Kim and Sung Wook Jung were not included on the oath/declaration.
5. It is for the Substitute Reissue Declaration filed April 23, 2009, that the petition requests acceptance, via suspension or waiver of the regulations. Applicant files the present petition and asserts that the nonsigning inventors cannot be found

DECISION

The provisions of 35 U.S.C. 251, which are directed to reissue of patents, does not address the signature requirements of an oath or declaration in reissue. 37 CFR 1.172 requires that a reissue declaration be made (and signed) by the inventors, except as otherwise provided (§§ 1.42, 1.43, 1.47), where the scope of the claims of the original patent is being enlarged. 37 CFR 1.175(b)(1), requires that:

“For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a **supplemental oath or declaration** stating that every such error arose without any deceptive intention on the part of the applicant.”

37 CFR 1.175(b)(1), taken in conjunction with 37 CFR 1.172, requires a supplemental declaration to be signed by all the inventors. This is because all oaths or declarations necessary to fulfill the rule requirements in a reissue application are taken together collectively as a single oath or declaration. Thus, each oath and/or declaration must bear the appropriate signature of all the inventors. *See In re Hayes*, 53 USPQ2d 1222 (Comm’r Pat. 1999).

In the present instance, the supplemental declaration is not signed by three inventors

¹ Inventor Hong was not identified as an inventor in the reissue oath/declaration filed in response to the Notice to File Missing Parts of Reissue Application, filed on May 10, 2004, and is being added as an inventor in the reissue application.

The MPEP 1414.01, Supplemental Reissue Oath/Declaration, states:

If a joint inventor refuses or cannot be found or reached to sign a supplemental oath/declaration, a supplemental oath/declaration listing all the inventors, and signed by all the available inventors may be filed provided it is accompanied by a petition under 37 CFR 1.183 along with the petition fee, requesting waiver of the signature requirement of the nonsigning inventor.

Suspension of the rules under 37 CFR 1.183 may be granted in an "extraordinary situation, when justice requires." The facts presented on the record do not adequately establish an extraordinary situation. Petitioner has not sufficiently established any special circumstances of equities that would require suspension of the rules in the interests of justice.

There is no requirement for a showing under 37 CFR 1.47, as noted above. This application bears an original Declaration executed by all joint inventors, and thus, the provisions of 37 CFR 1.47 do not apply in this instance. Nevertheless, it is appropriate to apply the principles thereof to the present situation in deciding whether this is an extraordinary situation.

Specifically, where an inventor is unavailable (cannot be reached), Applicant must establish the exercise of diligent effort in trying to find or reach the nonsigning inventor. A statement of facts should be submitted from a person with first hand knowledge of the facts relied upon that fully describes the exact facts which are relied on to establish that a diligent effort was made to locate the inventor. See, MPEP § 409.03(d). At the very least, an Internet search, or a search of telephone directories should be undertaken of the regions where it is suspected the non-signing inventor may reside. Copies of the results of such searches must be referred to in any renewed petition. It is important that the forthcoming communication contain statements of fact as opposed to conclusions. See, MPEP § 409.03(d). (Emphasis supplied).

MPEP 409.03(d).

Analysis

Applicant files the present petition wherein Applicant asserts that the nonsigning inventors cannot be found; however, Applicant has not presented evidence to support a conclusion that the inventors cannot be found or reached after diligent effort. At the very least, an Internet search, or a search of telephone directories should be undertaken of the regions where it is suspected the non-signing inventors may reside. Copies of the results of such searches must be referred to in any renewed petition. A statement of facts should be submitted from a person with first hand knowledge of the facts relied upon that fully describes the exact facts which are relied on to establish that a diligent effort was made to locate the inventors.

Conclusion

The petition is dismissed without prejudice. Applicant should file a request for reconsideration of petition and demonstrate that the nonsigning inventors cannot be found or reached after diligent effort.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Director for Patents
 PO Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

By hand: Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

/Derek L. Woods/
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Office of Petitions